

REMARKS

1. Summary of the Office Action

In the Supplemental Final Office Action mailed January 23, 2009, the Examiner (1) rejected claims 1-11, 14, 22, 26-28, and 30 under 35 U.S.C. § 102(b) as being unpatentable over European Patent Application Publication No. 1058217 (Prasad), and (3) rejected claims 12, 13, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application Publication No. 1058217 (Prasad), in further view of U.S. Patent Application Publication No. 2002/0128967 (Meyer et al.).

Applicant respectfully submits that as amended the claims are novel, non-obvious, and allowable, and thus requests that the rejections to these claims be withdrawn.

2. Status of the Claims

Presently pending are claims 1-24, 25-28, and 30, of which claims 1, 15, 27 and 28 are independent. The Amendments to the Claims in Applicant's June 19, 2008 Response (the "Previous Response") are included herein for reference. No additional amendments have been made in this response.

3. Consideration of Previous Claim Amendments

Applicant respectfully submits that the Examiner has not properly considered the claim amendments submitted with Applicant's Previous Response. In particular, Applicant amended claims 1, 5-9, 11-15, and 27-28, canceled claims 25 and 29, and added new claim 30, in the Previous Response. While the Examiner stated that the amended claims were "accepted for examination" and overcame the previous § 112 rejection, it does not appear that the Examiner has considered the amended claims in maintaining the § 102 and § 103 rejections. For example, the Examiner has not considered features such as a network "for processing payments

corresponding to the first and second payment card transactions, thereby debiting said first merchant and crediting said second merchant,” or the claimed terminals that, as amended, are characterized specifically as first and second “merchant terminals,” among other features. Furthermore, the Examiner again rejected claims 25 and 29, both of which were cancelled in the Previous Response.

In view of the foregoing, Applicant respectfully requests that the finality of the Office Action be withdrawn, so that the amendments from the Previous Response may be considered by the Examiner. Furthermore, for reasons set forth below, Applicants also submit that in light of the amendments in the Previous Response, claims 1-24, 26-28, and 30 are allowable.

4. Response to 35 U.S.C. § 102(b) Rejection of Claims 1-11 and 14, 22, and 25-29

As noted above, the Examiner rejected claims 1-11 and 14, 22, 25-28, and 30 under 35 U.S.C. § 102(b) as being unpatentable over Prasad. Applicant respectfully submits that because the Examiner has not considered the previous amendments of claims 1, 5-9, 14, and 27-28, the Examiner has failed to establish a *prima facie* case for anticipation of these claims. Furthermore, for the reasons set forth in the Previous Response, Applicant respectfully submits that Prasad does not teach or suggest each and every element of claims 1-11 and 14, 22, 25-28, and 30, as amended. Applicant’s previously presented arguments are set forth below for reference.

A. Claims 1-11 and 14

At the least, Prasad does not teach or suggest the features of claim 1 involving (a) receiving an indication from a first cardholder at a first merchant terminal that a transfer of funds is required to a second cardholder (b) generating a first payment card transaction at the first merchant *terminal* between said first merchant and said first cardholder, and (c) generating a

second payment card transaction at the second merchant *terminal* between said second merchant and said second cardholder.

Prasad discloses a system and method that uses a “transfer” account that can be accessed by a “sibling card” distributed by the account owner. According to Prasad, the account holder specifies that one or more "sibling" ATM, debit and/or Smart cards be linked to the transfer account and be able to access funds in the transfer account, wherein the account holder provides the sibling card to individuals of the account holder's choosing to provide the selected individuals with access to the funds specified for the particular sibling card. Prasad explicitly states that the core inventive principle is the attachment of an ATM, debit and/or "Smart" card to an account that allows specified access to the account but is not held by an owner of the account.

While Prasad labels an account as a “transfer” account, there is no actual “transfer” to speak of, only “communal provisioning” of what is for all intents and purposes is a joint account. According to claim 1, an indication is received from the first cardholder, at the first merchant terminal, that a transfer to the second cardholder is required. The steps to carry out this transfer, which involve the first and second payment card transfers, then occur. Thus, claim 1 involves two distinct transactions that are related in that the indication from the first cardholder coordinates the transaction. There is simply no such relation or coordination between transactions in Prasad. In Prasad, once access to the account is granted, the account owner deposits funds as they see fit, and within the established limitations, the holder of the sibling card can access and withdraw funds as they see fit.

In addition, Applicant respectfully submits that the Examiner’s reading of Prasad’s “sibling card” on the claimed “cardholder” feature is incorrect. Practically, Prasad substitutes the bank customer for the bank as the card issuing entity (and as the entity that grants access to

the account). Since all of the system (and/or method) features taught by Prasad for the establishment of “sibling card” access to the account, differ greatly from the steps required of the first and second cardholder to participate in the first and second transactions, the claimed cardholders cannot be equated to sibling cards.

Further, Applicant respectfully submits that in reading Prasad’s “ATMs” on the claimed first and second merchants, the Examiner has overlooked the technical feature of the said first and second merchants – the claimed transactions are between respective cardholders and merchants, not between respective cardholders and merchant *terminals*. It is hoped that the claims amendments submitted herewith will render the distinction clearer.

For the foregoing reasons, Applicant submits that Prasad does not teach or suggest each and every element of claim 1. Claims 2-11 and 14 are dependent on claim 1. Therefore, Applicant submits that claims 2-11 and 14 are novel and allowable for at least the reason that claims 2-11 and 14 depend from an allowable base claim. Accordingly, Applicant requests that the § 102(b) rejection in regards to claims 1-11 and 14 be withdrawn.

B. Claims 15-21, 22 and 26-28

While it is unclear from the Office Action whether or not claims 15-21 are included in the § 102(b) rejection, Applicant will assume, for sake of completeness, that claims 15-21 were included in this rejection. Claim 15 involves features that are similar to those of claim 1. In particular, claim 15 involves (a) means for receiving an indication from said first cardholder at said first merchant terminal that a transfer of funds is required to said second cardholder; (b) means for generating a first payment card transaction at a networked the first merchant terminal between said first merchant and said first cardholder, wherein said first payment card transaction is a first immediate transfer, debiting said funds from said first cardholder and crediting said

funds to said first merchant; and (c) means for generating a second payment card transaction at a networked the second merchant terminal between said second merchant and said second cardholder, wherein said second payment card transaction is a second immediate transfer, debiting said funds from said second merchant and crediting said funds to said second cardholder. As explained above in relation to claim 1, Prasad does not teach or suggest such features.

As such, Applicant submits that claim 15 is novel and allowable. Claims 16-22 and 26-28 are dependent on claim 15. Therefore, Applicant submits that claims 16-22 and 26-28 are novel and allowable for at least the reason that claims 16-22 and 26-28 each depend from an allowable base claim. Applicant also submits that new claim 30, which also depends from claim 15, is also novel and allowable as depending from an allowable base claim. Accordingly, Applicant requests that the § 102(b) rejection in regards to claims 15, 22 and 26-28 be withdrawn.

5. Response to 35 U.S.C. § 103(a) Rejection of Claims 12, 13, 23 and 24

As noted above, the Examiner rejected claims 12, 13, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Prasad and Meyer. Applicant respectfully submits that because the Examiner has not considered the previous amendments of claims 1, 5-9, 14, and 27-28, the Examiner has failed to establish a *prima facie* case for anticipation or obviousness of the base claims upon which these claims depend. Furthermore, for the reasons set forth in the Previous Response, Applicant respectfully submits that the combination of Prasad and Meyer does not teach or suggest each and every element of claims 1-11 and 14, 22, 25-28, and 30, as amended, and that the subject matter of claims 12, 13, 23 and 24 does not logically follow from

the teachings of Prasad and Meyer. Applicant's previously presented arguments are set forth below for reference.

As discussed, Prasad does not teach or suggest the features of claim 1 and 15 involving receiving an indication from a first cardholder that a transfer is required, and generating a first transaction (between the first cardholder and the first merchant terminal) and a second transaction (between the second cardholder and the second merchant terminal) to effectuate the transfer. The Examiner cites Meyer only as reading on claims involving identification of suitable merchants from details of the cardholder. However, Applicant submits that Meyer does not teach the above-described deficiencies in Prasad.

Therefore, claims 12, 13, 23, and 24 are allowable for non-obvious and allowable for at least the reason that claims 12, 13, 23, and 24 each depend from an allowable base claim. Accordingly, Applicant requests that the § 103(a) rejection in regards to claims 12, 13, 23, and 24 be withdrawn.

6. Conclusion

For at least the foregoing reasons, Applicant submits that claims 1-24, 26-28, and 30 are in condition for allowance and respectfully requests the Examiner to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney, at 312-913-3341.

Respectfully submitted,

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